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Application No.: 09/173,858

Atty Docket: JGR 1004-1

**REMARKS**

Claims 1-16 and 61-72 are pending in this action. They were previously rejected under 35 USC 103(a) as being unpatentable over McKendrick, *Banks begin to play with XML*, Bak Technology News, Sep.1998, Vol. 11, Iss. 9, pg. 6, 2 pgs, in view of W3C, *Extensible Markup Language (XML) 1.0*, 2/10/98, pages 1-37. These rejections have been repeated. The McKendrick reference cited is addressed by declarations to swear behind its publication date.

**Interview Report**

Applicants note with appreciation the Examiner's courtesy of a telephonic interview on 26 January 2005. During the interview, Applicants and the Examiner reviewed the limitations of claim 1, without any amendment being proposed. We also reviewed the McKendrick reference, *Banks begin to play with XML*, Bak Technology News, Sep. 1998, Vol. 11, Iss. 9, pg. 6, 2 pgs. The Examiner focused her reliance on two passages of McKendrick. On the first page,

Rowe Price is working with the one home banking vendor that's already melded XML into its products. Innovision Corp. recently began shipping its latest Open Financial Exchange (OFX)-based Financial Server product, capable of moving XML based protocols (See "OFX, Straight From The Heartland," December 1997 BTN). With both OFX and Open Buying On The Internet (OBI) striving to integrate XML into their respective electronic commerce standards, Innovision is certainly ahead of the curve.

And on the second page,

As such, XML may be just the ticket for providing better customer service. "Customer services are now migrating to Web sites from call centers and physical locations," states a report from Microsoft Corp. "And, because most of these business applications involve manipulation and transfer of data-such as purchase orders, invoices, customer information and appointments, XML will allow a rich array of business applications to be implemented."

As we understood the Examiner, primary reliance is placed on the second passage. The Examiner's reasoning was that use of XML format for messages is disclosed, but not the claimed invention. Use of XML formatted messages for purchase orders and invoices implies that an infrastructure would be required to support the messaging. An infrastructure would imply a definition of an interface. The need for an interface would imply the specific claimed limitations. Applicants deny this chain of inherency.

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At the end of the interview, the Examiner requested that Applicants' position be put in writing so that she could consult with her supervisor. No opportunity arose to negotiate an amendment that would place the case in condition for allowance.

**Request for Interview Including an Examiner Having Authority to Negotiate**

Resource person and senior Examiner Jack Harvey, a Section 101 panelist, was very helpful in moving this case along in 2003, by negotiating a minor amendment to the claim preamble to overcome a Section 101 rejection. The Section 101 rejection had been the subject of several responses to office actions and at least one interview prior to including in the interview process an examiner with authority to negotiate. Lacking the presence of an examiner with authority to negotiate, the Examiner wrote regarding a 3 December 2002 interview, "Discuss the 101 issue of the claimed limitations and case Lowry in MPEP. Examiner will consult with the 101 panel about this issue." Applicants have appreciated the Examiner's flexibility and willingness to bring in an examiner with authority to negotiate when the case stalled. It is stalled again, after six office actions and another interview.

MPEP § 713.05 all but makes it mandatory for an examiner with authority to negotiate to be included in the interview process when requested:

For an interview with an examiner who does not have negotiation authority, arrangements ***should always include*** an examiner who does have such authority, and who is familiar with the application, ***so that authoritative agreement may be reached at the time of the interview.***

MPEP § 713.05, at 700-204 (8<sup>th</sup> Ed. Rev 2, May 2004). With experience in this case and the guidance of the MPEP in mind, Applicants respectfully request an interview including an examiner who has authority to reach an agreement during the interview.

**Claim Rejections Under USC § 103(a)**

Claims 1-16 and 61-72 remain rejected under 35 USC 103(a) as being unpatentable over McKendrick<sup>1</sup>, *Banks begin to play with XML*, Bak Technology News, Sep 1998, Vol. 11, Iss. 9, pg. 6, 2 pgs, in view of W3C, *Extensible Markup Language (XML) 1.0*, 2/10/98, pages 1-37. Given the date of McKendrick, Applicants need only

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<sup>1</sup> It appears that the Microsoft report referenced in McKendrick is available from Microsoft's web site at <http://msdn.microsoft.com/archive/default.asp?url=/archive/en-us/dnarxml/html/xmlwp2.asp>. accessed January 29, 2005.

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show actual reduction to practice three weeks before filing of this application in order to remove McKendrick as a reference.

With this response, Applicants submit declarations under 37 CFR 1.131 to "swear behind" the McKendrick reference relied upon by the Examiner. These declarations were first submitted in related application 09/633,365, entitled "Registry for Trading Partners Using Documents for Commerce in Trading Partner Networks," which has the same priority date as this application.

The inventors declared that:

Prior to March 11, 1998, we had implemented a registry for trading partners. The registry was used in a method, also implemented prior to March 11, 1998, in a form sufficient to demonstrate that the method would work for its intended purpose, for establishing transactions among trading partners in a network, comprising: maintaining a registry of machine-readable specifications specifying business services offered by trading partners, the machine-readable specifications including at least one of definitions of, and references to definitions of, services offered and at least one of definitions of, and references to definitions of, documents to be exchanged with such services by trading partners; and providing, in response to a request, one or more of the machine-readable specifications from said registry is via a communication network to a requesting node.

To assist the Examiner's review of the declarations, Applicants point to the evidence in Exhibit A that corroborates the clear declarations of the inventors. One needs only to understand the corroborating evidence from the perspective of one of ordinary skill in the art. The explanation following was accepted in the related case as showing that Exhibit A corroborates the declarations.

There is evidence of machine-readable specifications. First, Exhibit A says, "CBL (Common Business Language) enables semantic interpretation and integration of different commerce applications. CBL defines the metadata for making a business and its services a self-describing 'eCo component'; ... it represents the forms and messages needed for commercial transactions". Metadata, in this context, is machine-readable. Citing the 1990 Std 610.5 *IEEE Standard Glossary of Data Management Terminology*, the *IEEE Standard Dictionary of Electrical and Electronics Terms* (6<sup>th</sup> Ed.) (1996), at page 648, gives as the first definition of metadata, "Data that describes other data; for example, a data dictionary contains a collection of metadata." Second, the evidence is that, "The development of CBL has strongly shaped the requirements for the eCo

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runtime platform. XML is now at the core of the eCo architecture, and the eCo server can be thought of as an XML processing platform on which CBL is the reference application. The use of XML inside the eCo platform as well as in its applications has enabled the server to be more capable and extensible than we conceived at the time of the proposal." XML is machine-readable data that was used inside the eCo server to represent messages needed for commercial transactions. Each of these excerpts demonstrates that machine-readable specifications were being used in the eCo server, corroborating the declarations.

There is evidence that the machine-readable specifications included definitions of services offered and documents to be exchanged with such services, in the first passage above. The CBL registry makes a business and its services self-describing. Looking again to the *IEEE Standard Glossary of Data Management Terminology*, the *IEEE Standard Dictionary of Electrical and Electronics Terms* (6<sup>th</sup> Ed.), at page 961, the definition of "self-descriptiveness" is, "The degree to which a system or component contains enough information to explain its objectives and properties." The metadata represents the forms and messages needed for commercial transactions, which understandably includes input and output messages or documents. In this context, messages and documents are interchangeable. XML was used both to define the messages passed and in the message payloads. More detail, including examples of XML code, are part of the application itself. The declarations are corroborated.

There is evidence that the data is adapted for parsing, as that is the nature of XML. Again, the declarations are corroborated.

When the corroborating evidence is evaluated from the perspective of one of skill in the art, the declarations are fully supported and corroborated. The declarations are effective to remove McKendrick as a reference.

Therefore, Applicants respectfully submit that claims 1-16 and 61-72 should be allowable over McKendrick in view of W3C.

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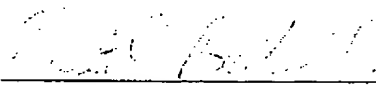
**CONCLUSION**

Applicants respectfully submit that the pending claims are now in condition for allowance and thereby solicit acceptance of the claims, in light of these remarks.

Productive as the first interview was, an additional interview is invited. The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 to 5:30 PST, M-F and can be reached at his cell phone (415) 902-6112 most other times.

Respectfully submitted,

Dated: January 31, 2005

  
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